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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,409	03/28/2002	Hideki Aikoh	10873.882USWO	4963
23552	7590	04/14/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			DINH, TAN X	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 04/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/089,409

Applicant(s)

AIKOH ET AL.

Examiner

TAN X. DINH

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) ☐ Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

1) This application is a 371 of PCT/JP00/07796, filed on 11/06/2000; which has foreign priority application number 11-323,315 filed in JAPAN on 11/12/1999.

2) The claims have been submitted under amendment form of PCT, claim 7 has been canceled.

3) The I.D.S filed 6/04/2003 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

4) The drawings are objected to because figures 3A and 3B should be designated by a legend such as -- PRIOR ART -- since only that which is old is illustrated. See MPEP § 608.02(g).

#### INFORMATION HOW TO EFFECT DRAWING CHANGES

##### a) REPLACEMENT DRAWING SHEETS.

Drawing changes may be made by presenting replacement figures which incorporate the proposed changes and which comply with 37 CFR § 1.84. An explanation of the changes made must be presented in either in the drawing amendments or remarks section of the amendment.

Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing

on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing should not be labeled as "amended"

If the changes to the drawing figure(s) are not approved by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application serial number or docket number (if any) if an application serial number has not been assigned to the applicant. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

b) ANNOTATED DRAWING SHEETS.

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the Examiner. The annotated drawing sheet must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

c) TIMING OF CORRECTIONS.

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice Of Allowability (PTO-37), the new drawings MUST be filed within the *THREE MONTHS* shortened statutory period set for reply in the "NOTICE OF ALLOWABILITY". Extensions of time may *NOT* be obtained under the provisions of 37 CFR §1.136 for filing the corrected drawings after the mailing of a NOTICE OF ALLOWABILITY.

5) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested.

MAGNETO-OPTICAL DISK HAVING ULTRAVIOLET CURABLE RESIN  
PROTECTIVE LAYER COATED WITH SILICONE OIL.

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

7) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8) Claims 12 is rejected under 35 U.S.C. 102(b) as being anticipated by APPLICANT PRIOR ARTS ( figures 3A and 3B ).

APPLICANT PRIOR ARTS ( figures 3A and 3B ) shows an optical disk device as claimed in claim 12, comprising a floating type or a sliding type magnetic head and an optical head ( Figs.3A&3B, magnetic head 3, optical head 2, 1 ), and the optical disk device allowing recording and/or reproduction with respect to a magnetic

field modulation type magneto-optical disk ( specification, pages 1-7 ).

9) Claims 1,3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by NAGATAKI et al ( 5,527,479 ).

NAGATAKI et al discloses a magneto-optical recording medium as claimed in claims 1,3 and 5, comprising:

A substrate ( Fig.1, substrate 1 );

A pit information surface ( Fig.1, 3 ) ;

A protective layer formed of an ultraviolet curable resin coated with silicone oil ( Fi.1, protective layer 6 coats with silicone oil layer 7. see also column 5, lines 45-53 ), which suites for floating type magnetic field modulation of sliding type magnetic field modulation ( column 1, lines 9-18 and column 2, lines 1-6 ).

10) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of

the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12) Claims 2,4,6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAGATAKI et al ( 5,527,479 ).

NAGATAKI et al discloses discloses a magneto-optical recording medium as claimed in claims 2 and 4, comprising a substrate ( Fig.1, substrate 1 ), a pit information surface ( Fig.1, 3 ), a protective layer formed of an ultraviolet curable resin coated with silicone oil ( Fig.1, protective layer 6 coats with silicone oil layer 7. see also column 5, lines 45-53 ), which suites for floating type magnetic field modulation of sliding type magnetic field modulation ( column 1, lines 9-18 and column 2, lines 1-6 ), *except* to specifically shows a printing layer. However, the technique of using printing layer for labeling the optical disk are widely used in the art ( every optical disk, such as, CD, DVD or MD are included a printing layer for displaying the graphic, label or other information related to the optical disk ). Therefore, to include a printing layer in NAGATAKI et al's optical disk as claimed is deem obvious to someone within the level of skill in the art.

As to claim 6, the disk cartridge for housing optical disk is old and well known in every mini-disk (MD) as seen in the prior

art figures 3A and 3B.

As to claim 8, it would have been obvious to coat a lower viscosity on read-only optical disk than magnetic field modulation type magneto-optical disk since on read-only optical disk the magnetic head does not perform recording and erasing, just reproducing only, during sliding or floating, the magnetic head and the protective layer will be damaged, by coating a lower viscosity on read-only optical disk the damage of magnetic head and protective layer is reduced to minimal.

As to claims 9 and 10, it would have been obvious to record an identification data on the optical disk or optical disk cartridge since the method for identification of any characteristic on the optical by labeling have been widely used in the optical recording art.

13) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure ( See form PTO-892 attached herein ).

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

14) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH



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whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH  
PRIMARY EXAMINER  
April 9, 2004